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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/228,325	01/11/1999	LARRY STEVENS	1002.2.72	8737

22913 7590 07/30/2003

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &  
SEELEY)  
60 EAST SOUTH TEMPLE  
1000 EAGLE GATE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/30/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/228,325

Applicant(s)

STEVENS, LARRY

Examiner

Michael Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on board decision 3/27/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Upon consideration of comments made in the Board of Appeal's decision issued March 27, 2003, which established that the examiner had not established a prima facie case under the standards set in the cited case law requiring sufficient motivation and nexus between the combined prior art, prosecution on the merits of this application is reopened. The final rejection mailed 4/11/01 is withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Chung, Hankele and Skedleski et al and Dow Q3-6093. Applicant has stated that the use of double sided adhesive tape to attach backboards to a frame structure is old (pg 2-line 3-17). The applicant also admits that the use of double sided tape was inadequate in that it was costly and time consuming (pg 2-line 9-14). A workman in the art in view of this deficiency, would have looked for other equivalent but better means of attachment in the sporting goods adhesive art. The workman would have noted the art of Chung, Hankele and Skedleski et al, each of which provide similar equivalent adhesive attachment

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means for sporting goods. Chung discloses that the "attachment of sports articles can be secured by suitable and conventional means" which include using "silicone glue" (4:29-30). Hankele discloses the use of any of the adhesives known in the art, such as "epoxy or silicone adhesives" (2:34-37). The Skedleski et al (4792316) art discloses using a "suitable means of attachment such as silicone adhesive (1:46-49) and using a primer to improve adhesion (1:61-64). The Skedleski et al (4955314) art also discloses the desirability of the silicon adhesive having a cushioning effect (2:60-64).

The art of Chung, Hankele and Skedleski et al clearly shows that those knowledgeable in the sporting goods adhesion art were aware of silicon adhesives and their suitability and advantages when considering cost, cushioning and superior adhesive qualities where sporting goods will be used under severe conditions, such as outdoors.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a silicone adhesive as taught by Chung, Hankele or Skedleski et al in order to lower production costs and manufacture a more durable backboard in order to increase the player's satisfaction with the product. Also it would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization expected by one of skill in the art (In re Leshin, 227 F2d197,125 USPQ 416(CCPA 1960). It should also be noted that no unexpected or

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extraordinary results were obtained by applicant in using the silicone adhesive. The applicant was merely following the recommended procedure for using the adhesive.

As to claim 2: No criticality is seen in the bond gap claimed. It would have been obvious to one of ordinary skill in the art of adhesives to have selected an appropriate thickness of and amount of adhesive according to manufacturer's use suggestions in order to insure the backboard remained attached during play. No extraordinary/unanticipated results are observed from using these ranges.

As to claims 4,-6, 14 and 15: It not apparent that there is any criticality in the type of silicon adhesive used. It would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization expected by one of skill in the art. One of ordinary skill would have followed the manufacture's recommended usage and curing times to insure an adequate bond was made.

As to claim 4: Applicant's specification discloses that Dow Q3-6093 is a catalyzed silicone adhesive (pg 5- lines 10-15). It would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization expected by one of skill in the art.

As to claim 5: Dow Corning Data sheet (Q3-6093) discloses a similar set time. Dow Corning Data sheet (Q3-6093) discloses that the working time and snap time are 15 minutes and 25 minutes respectively for a cure ratio of 10:1. The datasheet discloses the curing and set times are adjustable based on the amount of curing agent used (Fig 1-pg 2). A cure ratio of 8:1 would provide a working time and snap time of 9 and 15 minutes respectively ( $15/25=0.6$   $15*0.6=9$ ). One of ordinary skill in the art would have followed the manufacture's suggested application rules to insure a satisfactory bond.

As to claims 6 and 15: Dow Corning Data sheet (Q3-6093) discloses a similar set time. Dow Corning Data sheet (Q3-6093) discloses a set time of 15-60 minutes (Fig 1-pg 2). It would have been obvious to one of ordinary skill in the art to have followed the manufacture's suggested application directions to insure a satisfactory bond.

Claims 8-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 14 in view of Official Notice. Official Notice is taken that the use of glass bead spacers is well known in the adhesive art (Spheriglass webpage+ adhesion society lit review abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed glass beads with the device in order to maintain the proper adhesive thickness in order to insure there was proper bonding between the backboard and the frame.

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Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 in view of Official Notice. Official Notice is taken that the use of painted metal frames is well known in the basketball goal art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a painted metal frame in order to provide a low cost structure that was attractive in order to increase sales.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 in view of Official Notice. Official Notice is taken that the use of printed images on the backboard is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a printed image on the backboard to insure the proper position was maintained during the bonding operation in order to reduce the number of defective and misaligned backboards and lower total production costs.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

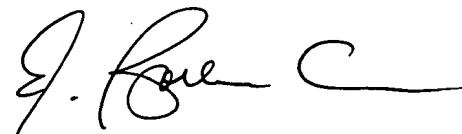
4792316\*4955314\*6056622\*3809401\*5839982

Michael Chambers  
Examiner  
Art Unit 3711

July 22, 2003

Approval for reopening prosecution:

Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700



**E. ROLLINS-CROSS  
GROUP DIRECTOR  
TECHNOLOGY CENTER 3700**